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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/674,135	09/29/2003	Erik Monsen	F-709	2500
7590 Pitney Bowes Inc. Intellectual Property and Technology Law Dept. 35 Waterview Drive P.O. Box 3000 Shelton, CT 06484			EXAMINER LIOU, ERIC	
			ART UNIT 3628	PAPER NUMBER
			MAIL DATE 09/20/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/674,135	<b>Applicant(s)</b> MONSEN ET AL.	
	<b>Examiner</b> Eric Liou	<b>Art Unit</b> 3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 18 July 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 6-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 6-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>7/11/07</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Status of Claims*

1. Applicant has amended claim 1, canceled claims 4-5, and added claims 8-12. Thus, claims 1-3 and 6-12 remain pending and are presented for examination.

### *Response to Arguments*

2. Applicant's arguments filed 7/18/07 have been fully considered but they are not persuasive.
3. Applicant argues, "Schwartz does not disclose a first country indicia containing a unique number for the payment of carrier fees for a first country post office and a second country indicia containing a number for the payment of carrier fees for a second country post office." The Examiner notes, Schwartz discloses an indicia containing a unique number (Schwartz: paragraphs 0055; 0061, "payer's credit card account number"). Schwartz does not disclose a first indicia containing a unique number. However, It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the first indicia of Schwartz to have included an indicia containing a unique number as disclosed by Schwartz for the advantage of identifying a particular mail item. The Examiner further notes, Schwartz discloses a country post office (Schwartz: Figure 7, "705", "US Postage"; paragraph 0059). Schwartz does not disclose a second country post office. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the method of Schwartz to have included a second country post office as disclosed by Schwartz because the

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post office is one carrier that a customer can select out of many in the competitive mail shipping industry. See art rejection below for a further explanation.

4. Applicant argues, "Schwartz discloses the printing of one postal indicium. Schwartz does not disclose or anticipate the printing of a first country postal indicium and a second country postal indicium with a postage meter as claimed in claim 3 and 6." The Examiner respectfully disagrees. Schwartz discloses a human readable portion indicia 705 and a bar-code indicia 710 (Schwartz: Figure 7; paragraph 0011; 0059). The Examiner interprets indicia 705 and indicia 710 to be two different postal indicium. The Examiner further notes, indicia 705 is the first country postal indicium (US Postage) and indicia 710 is the second country postal indicium (payee, e.g. FedEx). See art rejection below for a further explanation.

### *Drawings*

5. The Examiner acknowledges amended paragraphs 0019 and 0027 of the specification and withdraws the previous objection.

### *Claim Rejections - 35 USC § 103*

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-3, 6-7, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schwartz et al., U.S. Publication No. 2002/0073040.

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8. **As per claim 1**, Schwartz discloses a method for paying for mail to be delivered from a sender in a first country to a recipient in a second country, comprising the steps of:

affixing a first indicia containing a number to mail for payment of carrier fees for a first country post office (Schwartz: Figure 7, “705” and “709”, “US Postage” and “Meter 12345678901234”; paragraph 0059);

affixing a second country indicia containing a number to the mail for payment of the carrier fees for the second country courier (Schwartz: Figure 7, “710” and “708”; Figure 8, “801b”, “801c”, and “801d”; paragraph 0011, “the payee of the money order represented by the indicium to be a courier (e.g., FedEx) different from the postal authority”; paragraphs 0059; 0061-0064 – The Examiner notes, it is basic knowledge of one skilled in the art at the time of the invention to recognize that FedEx is an international carrier that delivers mail to a second country. Thus, the Examiner interprets barcode 710 to be a second country indicia.), and

debiting a meter for the payment of the carrier fees for the first country post office and the carrier fees for the second country courier (Schwartz: Figure 1; paragraphs 0010; 0059).

9. The Examiner notes, Schwartz discloses an indicia containing a unique number (Schwartz: paragraphs 0055; 0061, “payer’s credit card account number”). Schwartz does not disclose a first indicia containing a unique number. However, It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the first indicia of Schwartz to have included an indicia containing a unique number as disclosed by Schwartz for the advantage of identifying a particular mail item.

10. The Examiner notes, Schwartz discloses a country post office (Schwartz: Figure 7, “705”, “US Postage”; paragraph 0059). Schwartz does not disclose a second country post office.

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However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the method of Schwartz to have included a second country post office as disclosed by Schwartz because the post office is one carrier that a customer can select out of many in the competitive mail shipping industry.

11. **As per claim 2**, Schwartz discloses the method of claim 1 as described above. Schwartz further discloses wherein the first indicia is a post office postal indicia (Schwartz: Figure 7, “705”; paragraph 0059).

12. **As per claim 3**, Schwartz discloses the method of claim 1 as described above. Schwartz further discloses a post office postal indicia (Schwartz: Figure 7, “705”; paragraph 0059). Schwartz does not disclose the second indicia is a post office postal indicia.

13. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the method of Schwartz to have included the second indicia is a post office postal indicia as disclosed by Schwartz because the post office is one carrier that a customer can select out of many in the competitive mail shipping industry.

14. **As per claim 6**, Schwartz discloses the method of claim 1 as described above. Schwartz further discloses the first and second indicia are affixed to mail by a personal computer meter (Schwartz: Figure 1; paragraphs 0008; 0023). Schwartz further discloses the use of postage meters to print postage indicia on mail pieces (Schwartz: paragraph 0007). Schwartz does not disclose the indicia are affixed to mail by a postage meter in the secure postage payment method.

15. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the method of Schwartz to have included indicia are affixed to mail

by a postage meter as disclosed by Schwartz because the postage meter is an effective machine used in the industry to meter mail.

16. **As per claim 7**, Schwartz discloses the method of claim 1 as described above. Schwartz further discloses wherein the first and second indicia are affixed to mail by a personal computer meter (Schwartz: Figure 1; paragraphs 0008; 0023).

17. **As per claim 12**, Schwartz discloses the method of claim 1 as described above. Schwartz further discloses reporting the payment of carrier fees for affixing the first indicia to the first country post office (Schwartz: paragraphs 0010; 0059); and reporting the payment of carrier fees for affixing the second indicia to the second country post office (Schwartz: paragraphs 0010; 0059). The Examiner notes, in paying the US Post Office and the payee for service, it is implied that both the US Post Office and the payee receive some form of a report or notification indicating a payment made.

18. Claims 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schwartz et al., U.S. Publication No. 2002/0073040 in view of Pintsov, U.S. Patent No. 6,125,357.

19. **As per claim 8**, Schwartz discloses the method of claim 1 as described above. Schwartz further discloses information contained in the first indicia and the second indicia (Schwartz: paragraphs 0059-0069); examining the first indicia information and the second indicia information (Schwartz: paragraph 0070); determining whether the first indicia, and the second indicia affixed to examined mail are legitimate (Schwartz: paragraph 0070; The Examiner notes, Schwartz discloses the step of verifying indicia (bar code 710). Schwartz does not disclose verifying human readable indicia 705 (first indicia). However, it would have been obvious to

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one of ordinary skill in the art at the time the invention was made to have modified the method of Schwartz to have included verifying human readable indicia 705 for the advantage of ensuring that postal data is correct prior to mailing a mail piece.).

20. Schwartz does not disclose storing indicia information in a database and comparing the information stored in the database with information examined to determine whether the indicia affixed to the examined mail are legitimate.

21. Pintsov discloses storing indicia information in a database and comparing the information stored in the database with information examined to determine whether the indicia affixed to the examined mail are legitimate (Pintsov: col. 8, lines 18-43).

22. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the method of Schwartz to have included storing indicia information in a database and comparing the information stored in the database with information examined to determine whether the indicia affixed to the examined mail are legitimate as disclosed by Pintsov for the advantage of identifying any mail that may be fraudulent.

23. **As per claim 9**, Schwartz in view of Pintsov discloses the method of claim 8 as described above. Schwartz further discloses the unique number contained in the first indicia and the number contained in the second indicia as described above. Schwartz does not disclose utilizing the number contained on indicia to determine whether indicia affixed to the examined mail are legitimate.

24. Pintsov discloses utilizing the number contained on indicia to determine whether indicia affixed to the examined mail are legitimate (Pintsov: col. 8, lines 18-43).



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25. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the method of Schwartz in view of Pintsov to have included utilizing the number contained on indicia to determine whether indicia affixed to the examined mail are legitimate as disclosed by Pintsov for the advantage of identifying any mail that may be fraudulent.

26. **As per claim 10**, Schwartz in view of Pintsov discloses the method of claim 8 as described above. Schwartz further discloses canceling the first indicia and the second indicia (Schwartz: paragraph 0070).

27. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schwartz et al., U.S. Publication No. 2002/0073040 in view of Pintsov, U.S. Patent No. 6,125,357 and further in view of Sansone, U.S. Patent No. 6,415,336.

28. **As per claim 11**, Schwartz in view of Pintsov discloses the method of claim 8 as described above. Schwartz further discloses the first and second indicia as described above. Schwartz in view of Pintsov does not disclose marking the indicia with a visible ink to distinguish a used indicia from an unused indicia.

29. Sansone discloses marking the indicia with a visible ink to distinguish a used indicia from an unused indicia (Sansone: Figure 7c; col. 7, lines 22-24).

30. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the method of Schwartz in view of Pintsov to have included marking the indicia with a visible ink to distinguish a used indicia from an unused indicia as disclosed by Sansone for the advantage of providing a clear indicator that an indicia is cancelled.

*Conclusion*

31. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

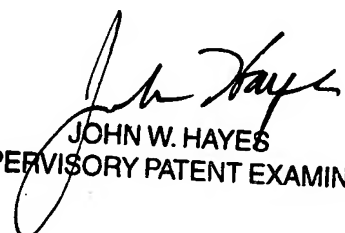
The Examiner has cited particular portions of the references as applied to the claims above for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the Applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Liou whose telephone number is 571-270-1359. The examiner can normally be reached on Monday - Friday, 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

EL

  
JOHN W. HAYES  
SUPERVISORY PATENT EXAMINER